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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,783	03/15/2002	Dieter Zimmermann	tesa 1514	4828
7590 03/01/2004 Norris, McLaughlin & Marcus P.A. 220 East 42nd Street, 30th Floor New York, NY 10017			EXAMINER ZIRKER, DANIEL R	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

101099783

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 12/29/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for the reasons set forth in paragraph No. 2 of Paper No. 0626. With respect to applicants' claimed "activator" it is again reiterated that the specification does not appear to have disclosed anything beyond the vague statement that such exists in the adhesive composition of the invention. With respect to applicants' remarks (Response, page 5) they are unfortunately believed not to further shed any light on the issue at hand. Additionally, with respect to applicants' disclosure on page 3 of "absorbent" it is again reiterated that the sole disclosure of "superabsorbent" found in the bottom paragraph on page 3 is inadequate to support applicants' claimed disclosure of "absorbent", applicants' remarks to the contrary notwithstanding. Note again also that this problem exists not only in the specification, but in the Markush grouping of claim 6.

3. Claims 1-11 are rejected under 35 USC 112, first

paragraph as being based on a defective specification.

4. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' admissions in the specification regarding the prior art set forth at page 1, bottom two paragraphs, taken in view of Ganster et al., (WO -328 is cumulative), substantially for the reasons set forth in paragraph No. 7 of Paper No. 0626, together with the following additional observations. Applicants' remarks (paragraph bridging pages 6 and 7) which are believed to traverse the rejection because the two performance parameters relating to the backing set forth in claim 1 are not specifically disclosed, is not found convincing.

Note that applicants' claim 3 sets forth the fact that the well known backings such as polyethylene, polypropylene and polyurethane found in the stretch release art are taught as suitable, and as such the Examiner firmly believes that the performance parameters would be, if not expressly disclosed clearly inherent in the stretch release backings set forth in applicants' admission. With respect to applicants' remarks (Response, page 7), it is noted that the relied upon admissions essentially teach the entire claimed invention except for the specific polyurethane adhesive formed, which is alleged as being inadequate. Ganster et al. is, as was clearly stated, relied upon as disclosing a superior polyurethane adhesive and as such

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the Examiner believes that there is more than ample motivation for one of ordinary skill to combine the prior art admission with Ganster et al. With respect to applicants' remarks that Ganster et al. fails to teach the polyurethane adhesive claimed by applicants, the Examiner can only note that the strongly believed extremely broad "aliphatic isocyanate/polyol cross-linking composition" is clearly either specifically disclosed or put within the skill of the art by the disclosure of Ganster et al. Note, e.g. column 2, lines 5 and 12-13, as well as column 3 lines 45 and 47 with respect to the presence of a suitable filler. Finally, "activators" are clearly believed to be, if not expressly disclosed, well within the ordinary skill of the art as applicants' remarks and their response would clearly tend to support. In summary, the Examiner respectfully submits that Ganster et al. teaches a polyurethane which is not "far different than that claimed by the applicants". Finally, with respect to applicants' allegations (Response, page 9, second and third paragraphs) that they have disclosed superior results the Examiner can only respectfully disagree. Applicants have made only a blanket traversal in their specification that the adhesive compositions of the closest prior art (Ganster et al.) are inadequate as compared to their polyurethane composition, but the Examiner can only regard such allegations, in the absence of a

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suitable comparative Declaration, as unsubstantiated attorney's allegations, not proven facts.

5. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00

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P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

February 23, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1800
1700

Daniel Zinker